

## **Discussion**

### Rejection under 35 USC §112.

The USPTO rejected Claims 1, 5 - 8, 10 - 14, 19, 21 and 24 under 35 USC §112, second para., as being indefinite. The basis of the rejection was a claim limitation that had been added to Claim 1 in the last Amendment, whereby the ratio of the R1:B in the composition of the claimed aminoplast ether copolymer is 1.5 to 4:1. The Examiner asserts that this ratio is not consistent with other limitations of Claim 1. In response thereto, the Applicants have deleted this claim limitation from Claim 1 of the application. As a result the Applicants assert that the rejection under §112 has been overcome. Note, however, that no new search is necessitated by this Amendment as the claim limitation being deleted was not present, and therefore need not have been searched, when the application was originally filed.

### Rejection under 35 USC §102 and 103.

The USPTO also rejected Claims 1, 5-8, 10-14, 19, 21 and 24 under 35 USC §102(a) as anticipated by or, in the alternative under 35 USC §103(a), as obvious over WO 02/12363, based on all translation thereof under US 2004/0102585. The publication date of WO 02/12363 is February 14, 2002, which date post-dates the application date for the priority German Application 101 63 985.6 (the

"German Application") from which priority is claimed for Application Serial No. 10/500,059, that is at issue.

The USPTO asserts that foreign priority of the German Application can not yet be claimed pursuant to MPEP 201.15 as an English translation of the Germany Application has not been made of record in accordance with 37 CFR 1.55.

In response, the Applicants submit as Exhibit A, an English translation of German Application, DE 101 63 985.6, along with a certification dated July 10, 2007 certifying a correct translation of the German Application. Under MPEP 201.15 the Applicants assert a right to claim priority from the German Application.

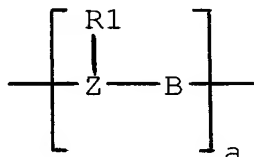
MPEP 201.15 acknowledges that once a translation of a priority document is submitted, which predates a cited reference, the reference will be overcome as long as the priority document discloses the invention as claimed in the claims of the application. To assist the Examiner in reviewing the English translation of the priority document to determine if Claim 1 is supported by the translation, the Applicants have compared Claim 1 with the disclosure in the German Application. The applicants assert that Claim 1, as amended, is supported by the English translation of the German Application. Basis for each element of Claim 1 within the English translation of the German Application is disclosed as follows:

Claim 1, as amended.

English translation  
of German Application

Water-soluble aminoplast ether  
copolymers of the following  
structural type:

Page 4, lines 4-10



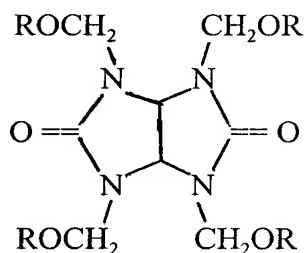
---

where:

Page 4, line 11,

Z comprises an aminoplast unit based  
on a glycolurile of formula

Page 10



Page 10

---

wherein R is selected from the group  
consisting of hydrogen, alkyl groups,  
and acyl groups;

Page 4, lines 13-  
16, Page 10, last 2  
lines, Figures 2.1,  
2.2 and 2.3

---

B comprises a radical of an  
essentially water-insoluble polymer

Page 4, lines 17-

selected from poly-n-butyl acrylate, poly-n-butyl methacrylate, polyethyl acrylate, polytetrahydrofuran, polyethyl methacrylate, polymethyl acrylate, polymethyl methacrylate, a predominantly aliphatic polycarbonate and a predominantly aromatic polycarbonate, which are able to react with the OR-function of the aminoplast unit,

---

20, Page 5, lines  
1 - 8

R1 comprises a radical of a hydrophilic organic compound containing at least one functional group which is able to react with the OR group of the aminoplast unit to form an ether bond,

---

Page 4, lines 21-24

selected from the group consisting of a radical of methylcellulose, polyacrylic acid, polymethacrylic acid, ethylene/acrylic acid/sodium acrylate copolymer, polyalkylglycol, polyvinyl alcohols and

Page 5, lines 9-14

polyvinylpyrrolidone, and

---

a is at least 1;

---

**Page 4, line 25**

wherein the overall mass of the  
water-soluble aminoplast ether  
copolymer is from about 2000 to 50  
000 g/mol.

**Page 5, lines 17-  
20, Page 6, lines  
1-5**

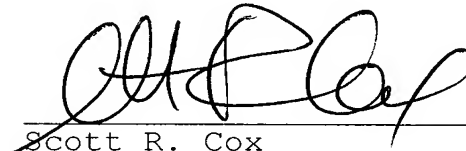
All remaining claims of the application are dependent claims depending on Claim 1 and therefore should also be disclosed by the specification of the German Application. If an analysis of the disclosure of each dependent claim is desired, please contact Applicants' counsel.

The Applicants therefore assert that the rejection based on WO 02/12363 has been overcome by the translation of the Germany Application.

### CONCLUSION

By the submission of the certified priority document, the Applicants have overcome the rejection based on WO 02/12363. The Applicants have also overcome the rejection based on 35 USC §112 by deleting the objected to language from Claim 1. As all objections and rejections have been overcome, the Applicants request the issuance of a Notice of Allowance. If there are any questions concerning this matter, please contact Applicants' counsel.

Respectfully submitted,



---

Scott R. Cox  
Reg. No. 31,945  
Customer No. 01695  
LYNCH, COX, GILMAN & MAHAN, P.S.C.  
500 West Jefferson, Suite 2100  
Louisville, Kentucky 40202  
(502) 589-4215

Dated: September 28, 2007

SRC:hh  
R:\Patents\p1223\Amendment\_092607.wpd  
40.12230  
9-27-07